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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/725,393

12/03/2003

Ajay Gupta

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(228150)

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EXAMINER

FOREMAN, JONATHAN M

ART UNIT

PAPER NUMBER

3736

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

02/28/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/725,393

Applicant(s)

GUPTA, AJAY

Examiner

Jonathan ML Foreman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 and 28-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 and 28-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 5 – 11, 28, 30, 32, 34, 36 – 42, 44 – 47, 49, 51 and 53 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,002,065 to LaCourse et al.

In regard to claims 1 and 5 – 11, LaCourse et al. discloses a combination electronic communication and medical diagnostic apparatus including a first component for transmitting or receiving a remote electronic communication signal (Col. 3, lines 35 – 38); and a second component (103) for generating vibration to be used in a medical diagnosis; wherein the second component generates vibration independently from the electronic communication signal received or transmitted by the first component (Col. 6, lines 24 – 30). The second component generates vibration of a fixed magnitude or of a variable magnitude in a linear manner (Col. 3, line 53 – Col.4, line 56). The second component generates vibration of a fixed frequency or of a variable frequency. The second component generates a plurality of sets each of a fixed magnitude or frequency (Col. 3, line 53 – Col.4, line 56). When the apparatus is applied to a subject, threshold for the perception or disappearance of vibration can be determined as a measure of nerve function to detect neuropathy (Col. 5, lines 58 – 60).

In regard to claims 28, 30, 32, 34, 36 – 42, 44 – 47, 49, 51 and 53, LaCourse et al. disclose a method including providing combination electronic communication and medical diagnostic apparatus including a first component for transmitting or receiving a remote electronic communication signal (Col. 3, lines 35 – 38); and a second component (103) for generating vibration to be used in a medical diagnosis; wherein the second component generates vibration independently from the electronic communication signal received or transmitted by the first component (Col. 6, lines 24 – 30). LaCourse et al. disclose generating vibration and applying the apparatus to the extremity of a subject (Col. 3, lines 43 – 46); and diagnosing neuropathy based on detection or non-detection of vibration by the subject (Col. 5, lines 58 – 60). LaCourse et al. discloses determining a threshold for the subject's ability to detect vibration of a predetermined magnitude or frequency. LaCourse et al. discloses determining a perception threshold for the subject's ability to detect vibration by increasing the magnitude or frequency of vibration. LaCourse et al. discloses determining a disappearance threshold for the subject's ability to no longer detect vibration by decreasing the magnitude or frequency of vibration (Col. 3, line 53 – Col.4, line 56). The vibration includes a predetermined magnitude or frequency equal to about 95th – 97th percentiles of a normal population. LaCourse et al. discloses a fixed magnitude or frequency or a variable magnitude or frequency (Col. 3, line 53 – Col.4, line 56).

3. Claims 1 – 26 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent Application No. 2003/0060765 to Campbell et al.

In regard to claims 1 - 26, Campbell et al. discloses a combination electronic communication and medical diagnostic apparatus including a first component for transmitting or receiving a remote electronic communication signal [0049][0054]; and a second component for generating vibration [0056] to be used in a medical diagnosis; wherein the second component generates vibration

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independently from the electronic communication signal received or transmitted by the first component [0056]. The communication signal comprises a wireless signal [0058]. The apparatus functions as a pager, beeper or cellular phone [0061]. The second component generates vibration of a fixed magnitude or of a variable magnitude in a linear manner [0056]. The second component generates vibration of a fixed frequency or of a variable frequency [0056]. The second component generates a plurality of sets each of a fixed magnitude or frequency. When the apparatus is applied to a subject, threshold for the perception or disappearance of vibration can be determined as a measure of nerve function to detect neuropathy. The apparatus includes an audio or visual display (18). The device generates vibration in a first and second mode; one of the first and second modes is utilized in an electronic communication [0061] and the other [0056] is capable of being utilized in a medical diagnosis. A recitation with respect to the manner in which an apparatus is intended to be employed does not impose any structural limitation upon the claimed apparatus that differentiates it from a prior art reference disclosing the structural limitations of the claim. *In re Pearson*, 494 F.2d 1399, 181 USPQ 641 (CCPA 1947); *In re Yanush*, 477 F.2d 958, 177 USPQ705 (CCPA 1973); *In re Finsterwalder*, 436 F.2d 1028, 168 USPQ 530 (CCPA 1971); *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); *In re Otto*, 312 F.2d 937, 136 USPQ 458 (CCPA 1963); *Ex parte Masham*, 2 USPQ2d 1647 (BbPatApp & Inter 1987). It is noted that the device as disclosed by Campbell et al. generates a vibration that is capable of being used in a medical diagnosis.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary

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skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 31, 33, 35, 48 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,002,065 to LaCourse et al. as applied to claims 30, 32, 34, 47 and 49 above, and further in view of US Patent No. 5,931,793 to Laudadio.

In regard to claims 31, 33, 35, 48 and 50, LaCourse et al. discloses determining a vibration threshold in order to diagnose a medical condition, but fails to disclose grading the threshold low, medium, or high when compared to a preset standard thereby indicating the severity of the medical condition. However, Laudadio discloses determining a vibration threshold and grading the threshold low, medium, or high when compared to a preset standard thereby indicating the severity of the medical condition (Col. 3, lines 18 – 25). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as disclosed by LaCourse et al. to grade the vibration threshold low, medium, or high when compared to a preset standard as taught by Laudadio in order to quantify minimal impairment, moderate neuropath and severe neuropathy (Col. 3, lines 18 – 25).

6. Claims 2, 29, 43, 52 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,002,065 to LaCourse et al. as applied to claims 1, 28, 42, 51 and 53 above, and further in view of US Patent No. 6,641,533 to Causey, III et al.

In regard to claims 2, 29, 43, 52 and 54, LaCourse et al. discloses an electronic communication device that transmits or receives a remote electronic communication signal (Col. 3, lines 35 – 38), but fails to disclose the signal comprising a wireless signal. However, Causey, III et al. teaches that remote electronic communication signals can be transferred over a wire or wirelessly (Col. 27, lines 51 – 54). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the electronic communication signal as disclosed by

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LaCourse et al. to be a wireless signal in that Causey, III et al. teaches a wired or wireless communication signal as being equivalents. Furthermore, the removal of wired connections would allow a user to be mobile while using the system.

Response to Arguments

7. Applicant's arguments filed 12/18/06 have been fully considered but they are not persuasive. Applicant asserts that LaCourse et al. fails to disclose a first component for transmitting or receiving a remote electronic communication signal; and a second component for generating vibration to be used in a medical diagnosis; wherein the second component generates vibration independently from the electronic communication signal received or transmitted by the first component. However, the Examiner disagrees. LaCourse et al. discloses a first component for transmitting or receiving a remote electronic communication signal (Col. 3, lines 35 – 38); and a second component (103) for generating vibration to be used in a medical diagnosis; wherein the second component generates vibration independently from the electronic communication signal received or transmitted by the first component (Col. 6, lines 24 – 30). The second component generates a vibration independently of any electronic signals received by the computer (102) from the pulse wave monitor (105) or the skin temperature monitor (104). Applicant asserts that Campbell et al. fails to disclose a first component for transmitting or receiving a remote electronic communication signal; and a second component for generating vibration to be used in a medical diagnosis; wherein the second component generates vibration independently from the electronic communication signal received or transmitted by the first component. Furthermore, Applicant asserts that Campbell et al. fails to disclose the apparatus functioning as a pager, beeper, or cellular phone. However, the Examiner disagrees. Campbell et al. disclose a first component for transmitting or receiving a remote electronic communication signal [0049][0054]; and a second

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component for generating vibration [0056] to be used in a medical diagnosis; wherein the second component generates vibration independently from the electronic communication signal received or transmitted by the first component [0056]. The infusion device receives a programming signal from a remote programming device. The vibrator located in the infusion device can vibrate independently from any communication signal received or transmitted by the remote programming device, such as in the case of a low level alarm. In as much as the infusion device can receive a signal from a remote device and acknowledge that signal, the device is considered to function as a pager or beeper. Additionally, Applicant asserts that Campbell et al. is not directed to a diagnostic device. However, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan ML Foreman whose telephone number is (571)272-4724. The examiner can normally be reached on Monday - Friday 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


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